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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,577	01/12/2000	Glenn R. Toothman, III		5806

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EXAMINER

LEE, DIANE I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 07/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/481,577

Applicant(s)

TOOTHMAN, LLL ET AL.

Examiner

Diane I. Lee

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 41-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 8.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 2876

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 08 May 2002. Claims 1, 9, 24, 28 have been amended; claim 55 has been newly added. Currently, claims 1-55 are pending in the application, wherein claims 41-54 are withdrawn from the consideration as being drawn to a non-elected invention.

Election/Restrictions

2. In response to applicant's statement that the Office Action (paper no. 6) incorrectly stated the election was made "without traverse", rather than correctly stating that the election was made "without prejudice"; the examiner has withdrawn the statement of "provisional election was made without traverse to prosecute the invention of Group I" which stated in paragraph 5 of the Office Action and correctly stating that "provisional election was made without prejudice to prosecute the invention of Group". Acknowledgement is made that applicant confirms the election of Group I, claims 1-40, without prejudice and with traverse.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-6, 17-18, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Assisi [US 5,696,488].

Re claims 1, 4-6 : Assisi discloses a system having a device for storing retrieval information relating a deceased person, the system comprising:

Art Unit: 2876

a computer 5 having a memory device 6 permanently affixed to a stationary physical object/location positioned at the cemetery location (i.e., the computer and the memory is directly located in the cemetery 1), the memorial information residing on the memory device that is a weather resistant memory device (see col. 1, lines 4+; col. 2, lines 7+; and the figure);

a portable memory reading device 3, 11 separate from the memory device of the cemetery location 1, that retrieves the memorial information directly from the memory device of the cemetery location when it is positioned at the cemetery location (i.e., wireless communication carried out when the portable memory reading device is brought into the vicinity of the memory device 2). The memorial information in the memory device of the cemetery location is in form of text, image or audio data of the deceased person in the cemetery (see col. 1, lines 35+ and col. 2, lines 23+);

Re claim 3: wherein the memory device contains personal information on the deceased person the device is connected to the transmitter/receiver device 2 so that the portable memory device can retrieve the information via wireless communication. Since the contents of the information stored in the memory device is determined by a person during his or her lifetime and that information is accessible via the reading device which clearly teaches that the memory device is a programmable read only memory device;

Re claim 17-18, 21-23: a central storage chamber 7 having a computer 5' as a communication controlling means and a storage device 6' as a database includes the memorial information residing on the memory device is replicated (see col. 2, lines 17+ and the figure). The computer 5 of the memory device having a restriction program to control the communication access to the memory device which inherently teaches that the memory device is uniquely associated with some sort of an identifying code (see col. 1, lines 36+).

Art Unit: 2876

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 7-16, 19-20, and 24-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi. The teachings of Assisi have been discussed above.

Due to the fact that Assisi discloses a system having an electronic storage in communication with a reading device (i.e., the reading device retrieving data in the storage) and Assisi further states that utilizing such system would provide unobtrusive communication between the visitor(s) and the site having a memory device, and the dignity of the location is not disturbed (see col. 2, lines 23+), it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to apply the Assisi's teaching in museum or historical site in order to further extend the utilization of the electronic storage in communication with a reading device (i.e., museum or historical site having an electronic storage storing historical/geographical information in communication with a reading device and the reading device retrieving the stored historical data in the storage). Furthermore, it would have been an obvious intended use of the system since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2USPQ2d 1647 (1978).

Re claims 2, 10, and 29: Assisi is silent with respect the memory device comprising a contact memory device.

Assisi teaches a system utilizing a wireless communication, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to substitute the contactless memory device to a contact memory due to the fact that contact reading device would not requires a transceiver

Art Unit: 2876

thereby it is cost effective and more reliable. Accordingly, it would have been an obvious substitution of equivalent therefore, it would have been an obvious expedient.

Re claims 7-8, 15-16, and 32-33: Assisi is silent with respect to the specific language format of the information resides on the memory device such as extensible markup language or hypertext markup language formats.

Assisi teaches that the information resides on the memory device may be in the form of text, image or audio data in any combination (see col. 1, lines 45-46).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize any suitable language format appropriate to the system. Furthermore, since applicant has not discloses that utilizing extensible markup language or hypertext markup language formats in the memory device would solve any stated problems or is for any particular purpose and it appears that the invention would perform equally well with any other applicable language/text format that is available. Therefore, it would have been an obvious design variation to a person skilled in the art. One might choose the specific text format in order to meet specific communication standards/requirements. Accordingly, it would have been an obvious expedient.

Re claims 19-20 and 36-37: with respect to accessing the information through an Internet or telephone network, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the Internet-based communication process in the system Assisi (i.e., storing the information in a database over the Internet server and retrieving the information over the Internet). Doing so would provide a convenience of retrieving the information at user's home. Official Notice is taken that retrieving data through the networks (i.e., includes telephone network and Internet) associated with unique identification code is old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. Thus, it would have been obvious to an artisan of ordinary skill in the art incorporate well-known network-accessible database and unique identification code to be associated with

Art Unit: 2876

the gathered data in the system of Assisi. Accordingly, it would have been an obvious extension taught by Assisi therefore, it would have been an obvious expedient.

7. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi in view of Downing [US 4,689,757-referred as Downing]. The teachings of Assisi have been discussed above.

The system of Assisi includes a wireless data connectivity between the memory device affixed a the cemetery to the portable memory reader which obviously includes a data interfacing or connecting port and the information directly passing from the memory device to the portable reader via wireless connection.

Assisi does not disclose the data connector and the information directly passing from the memory device to the portable reader upon the wire connection between the portable reader and the data connector, and upon contact with the memory device to the data connector.

Downing discloses the data connector 12 and the information directly passing from the memory device (counting machine 10) to the portable reader (transfer unit 16) upon the wire connection 18 between the portable reader and the data connector, and upon contact with the memory device to the data connector via the wire connection 14 (see col. 3, lines 5+ and figure 1).

In view of Downing's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide the direct wire connection for retrieving the information in the system of Assisi in order to provide a wire connection between the memory device and the reader to accommodate the reader without the wireless communication feature, thereby increasing the capability of the data connection.

Response to Arguments

8. Applicant's arguments filed s 5/08/02 have been fully considered but they are not persuasive.

Art Unit: 2876

9. Applicant argued with respect to claims 1, 9, 24, and 28 that non-portable transceiver is separated from the memory device and the storage device of Assisi is not so permanently affixed (see page 7, lines 6+). Assisi teaches that the non-portable transceiver is connected to the data cable 4 when the non-portable transceiver which affixed to the cemetery 1. Further, Assisi clearly teaches that the computer 5 having a memory device 6 is permanently affixed to a stationary physical object/location positioned at the cemetery location, i.e., the computer and the memory is directly located in the cemetery 1 (see col. 2, lines 17+). This clearly teaches that when the computer having a memory device is permanently affixed the cemetery location, the data cable would be eliminated.

10. In response to applicant's argument with respect to amended claims 1, 9, 24, and 28 that the portable reader of the present invention directly communicates with the memory device which is in contrast to the teaching of Assisi (see page 7, lines 21+); the examiner respectfully disagrees.

Assisi teaches that the portable memory reading device 3, 11 separate from the memory device of the cemetery location 1. In order to retrieve the memorial information, the portable memory reading device is brought into the vicinity to retrieve the data via wireless communication. This process of retrieving the data via wireless communication meets the claimed limitation of the portable reader directly communicating with the memory device 6 of the cemetery location.

11. Applicant argued with respect to claims 2, 7-16, 19-20, 24-40 that a prima facie case for obviousness has not been made without citation of a reference or references teaching the data structure taught in the instant application (see page 9, lines 4+). Although Assisi does not explicitly teach the physical location is historically notable location, the fact that Assisi discloses a system having an electronic storage in communication with a reading device (i.e., the reading device retrieving data in the storage) and wherein and Assisi further states that utilizing such system would provide unobtrusive communication between the visitor(s) and the site having a memory device, and the dignity of the location is not disturbed (see col. 2, lines 23+). Since there is no structural difference between the claimed

Art Unit: 2876

invention and the prior art other than difference in the intended use of the system (i.e., the physical location is historically notable location), it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to apply the Assisi's teaching in museum or historical site in order to further extend the utilization of the electronic storage in communication with a reading device (i.e., museum or historical site having an electronic storage storing historical/geographical information in communication with a reading device and the reading device retrieving the stored historical data in the storage). Since the system of Assisi having a memory device affixed to a physical object at the cemetery for retrieving the personal information relating to a deceased person obviously capable of performing the applicant's claimed invention (i.e., retrieving the historical information relating historical notable location) if Assisi's teaching is applied to an environment such as a museum or historical site. Therefore, it would have been an obvious intended use of the system since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2USPQ2d 1647 (1978).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

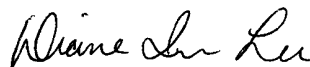
Art Unit: 2876

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Diane I. Lee
Primary Examiner
Art Unit 2876

July 24, 2002